



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

SW

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,867	09/05/2003	Robert A. VanTassel	593/CIP2DIV	7301
1473	7590	07/27/2004	EXAMINER	
FISH & NEAVE 1251 AVENUE OF THE AMERICAS 50TH FLOOR NEW YORK, NY 10020-1105			MENDOZA, MICHAEL G	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/655,867

Applicant(s)

VANTASSEL ET AL.

Examiner

Michael G. Mendoza

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-16 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11 December 2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5 and 11-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Lesh et al. 6152144.

3. Lesh et al. teaches an apparatus for attachment over an ostium of a left atrial appendage in a patient, comprising: a membrane 53 having an outer periphery with a dimension larger than a corresponding dimension of an ostium; and securement means (figs. 1, 3-7, 11, and 12); wherein the securement means is located between the outer periphery of the member and the atrial wall surrounding the ostium; wherein the securement means comprises an adhesive (col. 2, lines 13-17); wherein the adhesive is cyanoacrylate (col. 4, lines 62-64); wherein the securement means comprises a plurality of engagement member attached to the member at a plurality of location about the outer periphery of the membrane (fig. 6 and 7); wherein the securement means comprises a structure configured to extend distally from the membrane into the ostium (fig. 12); wherein the securement means is configured for enlargement in response to expansion of an expansion structure located in an interior portion of the securement means (col. 9,

Art Unit: 3731

lines 29-33); wherein the securement means is resiliently biased in an enlarged configuration for engagement with the interior wall of the left atrial appendage and may be constrained in a reduced size configuration for installation in the left atrial appendage (fig. 11); wherein the membrane has a permeable structure which allows blood to flow through the membrane but substantially inhibits thrombus from passing therethrough (col. 1, lines 64-67 thru col. 2, lines 1-6); wherein the member has an impermeable structure which substantially inhibits thrombus and blood from passing therethrough (col. 2, lines 39-41); wherein the securement means comprises membrane supporting structure attached to the outer periphery of the membrane (col. 7, lines 54-64).

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 5, 8-14, and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5-9 of U.S. Patent No. 6652556. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are broader in some respects

Art Unit: 3731

and add features in other respects. The structural limitations set forth in claims 1, 5, 8-14, and 16 of the instant application are also claimed in the patent, e.g., an apparatus for permanent placement across an ostium of a left atrial appendage in a patient, comprising: a filtering membrane having a permeable structure which allows blood to flow through but substantially inhibit thrombus from passing; a support structure to permanently engage the interior walls of the left atrial appendage; a support structure comprising a plurality of fingers comprising a barbed portion configured to engage an interior wall of the atrial appendage; an actuator to remotely expand the support structure; and wherein the membrane support is fabricated from a material having shape-memory characteristics.

The difference between claims of the instant application and claims of the patent is the membrane having an outer periphery with a dimension larger than a corresponding dimension of the ostium.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the membrane with an outer periphery with a dimension larger than a corresponding dimension of the ostium to completely seal of the ostium for preventing any gaps that would allow a thrombus to pass.

Allowable Subject Matter

6. Claims 6 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 3731

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Mendoza whose telephone number is (703) 305-3285. The examiner can normally be reached on Mon.-Fri. 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dawson can be reached on (703) 308-4304. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



MM
July 20, 2004



GLENN K. DAWSON
PRIMARY EXAMINER